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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,075	07/11/2003	Frank Friedland	732-A03-002	3596
27317	7590	07/14/2006	EXAMINER	
FLEIT KAIN GIBBONS GUTMAN BONGINI & BIANCO 21355 EAST DIXIE HIGHWAY SUITE 115 MIAMI, FL 33180				THANH, QUANG D
		ART UNIT		PAPER NUMBER
		3764		

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/618,075	FRIEDLAND, FRANK
	Examiner	Art Unit
	Quang D. Thanh	3764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 April 2006.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This office action is responsive to the amendment filed on 4/27/2006. As directed by the amendment: claims 1 and 15-17 have been amended; no claims has been cancelled nor added. Thus, claims 1-20 are presently pending in this application.

#### ***Response to Amendment***

2. The affidavit filed on 4/27/2006 under 37 CFR 1.131 is sufficient to overcome the Li (US 2004/0049138 A1) reference.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5-8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacey (US 2002/0049400 A1) in view of Wu (5,413,551).

5. Re claim 1, Lacey discloses a head massager (fig. 2) comprising a bundle of malleable rods 12 having a top member 20 within which the top end of the bundle of rods is fixed (wound together, fig. 2) and the rods are free at the bottom end of the bundle (fig. 2), a handle 22 including a top half and a bottom half (fig. 2), the bottom half defining a lower recess receiving the top member 20 fixed therein (fig. 2), a vibrator 26 having a motor, and a switch 30 provided on the handle 22 for selectively opening and closing an electric circuit 32 coupling the battery 26 to the vibrator (fig. 2), except it

is silent regarding the top half and bottom half articulated together, an output shaft having an eccentric magnet, a battery receiving plate, and a manually operable switch actuator for actuating the switch to enable power to be supplied to the motor. However, Wu teaches a massage device (fig. 2) comprising a top half and a bottom half portions articulated together, a vibrator having a motor 21, an output shaft having an eccentric weight 22, a battery receiving plate 16/24, and a manually operable switch actuator 27/13 for actuating the switch 26 to enable power to be supplied to the motor (fig. 2, col. 2, lines 8-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the device in the Lacey's reference, to include a top half and a bottom half portions articulated together, as suggested and taught by Wu, for the purpose of allowing easy exchange of the exhausted batteries (col. 2, lines 8-47), and to include a manually operable switch actuator located on the top portion for actuating the switch to enable power to be supplied to the motor (fig. 2, col. 2, lines 8-30).

Regarding the limitation the eccentric weight being "a magnet", it would have been an obvious matter of design choice to modify the device, to have an eccentric magnet, since applicant has not disclosed that having an eccentric magnet solves any stated problem or is for any particular purpose and it appears that the device would perform equally well with either designs. Furthermore, absent a teaching as to criticality that the eccentric weight being a magnet, this particular arrangement is deemed to have been known by those skilled in the art since the instant specification

and evidence of record fail to attribute any significance (novel or unexpected results) to a particular arrangement. *In re Kuhle*, 526 F.2d 553,555,188 USPQ 7, 9 (CCPA 1975).

Regarding the arrangement of the motor, the switch, the manually operable switch actuator and the battery receiving plate, it would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the elements mentioned above as claimed, since it has been held that rearranging parts of an invention involves only routine skill in the ad. *In re Japikse*, 86 USPQ 70. *In re Anderson's Black Rock Inc. v. Pavement Salvage Co. Inc.*, 163 USPQ 673.

6. Re claims 5 and 8, Wu also discloses a readily attachable and detachable latch 14/15 couples the top half to the bottom half (best seen in fig. 2); and Lacey discloses n the bottom portion includes an end cap 24 containing the recess (fig. 2).

7. Re claims 6-7, the combined references discloses the claimed invention except for the switch including a spring biased plunger and the manually operable switch actuator including a spring biased push button and actuating rod for contacting and closing the switch. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a spring-biased push-button switch to turn the power on/off, since the examiner takes Official Notice of the spring-biased push-button switch that is well known for their use in hand-held massaging device art, and the selection of any of these known equivalents to the power switch would be within the level of ordinary skill in the art.

8. Re claim 12, Lacey discloses protective coverings (smooth end) are mounted on the free ends 18 of the rods (fig. 2, paragraph 40).

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lacey/Wu in view of Harrison (6,110,102). The combined references discloses the claimed invention except for a transparent top haft of the handle. However, Harrison discloses a similar vibration device having a transparent handle (see abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the device to make the handle transparent, as suggested and taught by Harrison, for the purpose of improving the aesthetic appearance of the device, thus making the device to look more attractive.

10. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacey/Wu in view of Sorlie et al. (US D473,949 S). The combined references discloses the claimed invention except for the handle being decorated with figures and the bottom half is decorated with the face of a wizard. However, Sorlie teaches a head-massaging device having a handle with the bottom portion being decorated with the face of a wizard (fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the device to decorate the handle with a face, as taught by Sorlie, for the purpose of improving the aesthetic appearance of the device, thus making the device to look more attractive.

11. Claims 9, 12-13, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacey/Wu in view of Robbins et al. (US 2003/0083600 A1). The combined references discloses the claimed invention including protective coverings (round ends) mounted on the free ends of the rods, except for the bundle of rods contains rods of three different lengths and plastic balls constitute the protective coverings. However, Robbins teaches a head- massaging device having a bundle of rods containing rods of different lengths 22/2222 (fig. 22, paragraph 65) so that the top of the head may be simultaneously massaged with the fingers massaging the remainder of the head thereby increasing the pleasurable benefits of the massage and plastic ball coverings 30 (paragraph 43) to protect the scalp against injury. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the device to includes rods having different lengths and plastic ball covering, as taught by Robbins, for the purpose of increasing the pleasurable benefits of the massage (paragraph 65) and to protect the scalp against injury (paragraph 43).

12. Claims 10-11 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lacey/Wu/Robbins'600 in view of Robbins et al. (6,450,980 B1). The combined references discloses the claimed invention except for a visual indicator is marked on the bundle of rods showing where bends occur during rod deployment. However, Robbins '980 teaches a head- massaging device comprising a bundle of rods, each rod containing a bendable portion 124 and the bending may be accomplished by use of the plurality of visual indicator strips 132-136 (fig. 11, col. 4, lines 62-67) so that the rod can be bended under application of electrical current, thereby increasing the

pleasurable benefits of the massage. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the device to include visual indicator strips, as taught by Robbins, for the purpose of allowing the rods to contract and bend at the strip under application of electrical current thereby increasing the pleasurable benefits of the massage. With respect to the limitation "one visual indicator is marked on the rods about  $\frac{1}{4}$  of the lengths of the longest rods from the handle, and a second visual indicator is marked on the longest rods  $\frac{3}{4}$  of their lengths from the handle", it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the location of these strips on the rods, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

13. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lacey/Wu in view of Al-Killidar (6,899,106). The combined references discloses the claimed invention except for a light included in the electrical circuit. However, Al-Killidar teaches a massaging device having a switch 42 and a light 44 included in the electrical circuit (fig. 3) and coupled to the switch 42 for indicating actuation of the switch. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the device to include a light operatively coupled to the switch, as taught by Al-Killidar, for the purpose of providing an indication for the actuation of the switch (col. 4, lines 10-12).

***Double Patenting***

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

15. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

This is a provisional obviousness-type double patenting rejection.

16. Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 and 14-19 of copending Application No. 10/681,736 in view of Wu.

17. Re claim 1, claim 1 of copending Application No. 10/681,736 discloses all the claimed elements except for a top half and a bottom half of the handle, a battery receiving plate, an electrical circuit, a switch and a manually operable switch actuator and batteries. However, Wu teaches a massage device (fig. 2) comprising a top half

and a bottom half portions articulated together, a battery receiving plate 16/24 , an electrical circuit 28 and a manually operable switch actuator 27/13 for actuating the switch 26 to enable power to be supplied to the motor (fig. 2, col. 2, lines 8-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the device of the present application to include all the elements mentioned above, as suggested and taught by Wu, for the purpose of providing a support means (top and bottom half) for housing the device, a power supply means (batteries and battery receiving plate) for causing the vibration and a control means (switch and its actuator) for controlling the operation of the device.

18. Re claims 2-14, see claims 2-12 of copending Application No. 10/681,736.
19. Re claims 15-17, see claims 14-16 of copending Application No. 10/681,736 in view of Wu, which teaches that it would be obvious to include a handle having a top half articulated with a bottom half (see explanation above).
20. Re claims 18-20, see claims 17-19 of copending Application No. 10/681,736.

***Response to Arguments***

21. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang D. Thanh whose telephone number is (571) 272-4982. The examiner can normally be reached on Monday-Thursday & alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Huson can be reached on (571) 272-4887. The Central FAX phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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